

Group I: claims 1-19, drawn to a composition classified in Class 525, subclass 55+; and

Group II: claims 20-23, drawn to a method of using a composition classified in Class 424, subclass 70.16.

The Examiner further required election of a single disclosed species from among the anionic, cationic, amphoteric and nonionic fixing and conditioning polymers of claims 9-17. The Examiner also indicated that should the applicant elect Group II, the following election of species is required from the generic method of using the composition: the method of improving vaporization, claims 20-21, or the cosmetic treatment, claims 22-23.

This restriction requirement is the same one the Examiner required in the parent application, Serial No. 08/694,591, in the Office Action mailed May 14, 1997. Applicant respectfully traverses this rejection. However, to be responsive to the restriction requirement, Applicant elects, with traverse, Group I (claims 1-19) as well as the amphoteric species of claim 17, as amended.

Applicant's traversal of the restriction requirement is as follows. The Examiner's attention is invited to M.P.E.P. § 803, which sets forth criteria and guidelines for the Examiner to follow in making a proper requirement for restriction. The following passages are pertinent to the issue herein.

**CRITERIA FOR RESTRICTION BETWEEN  
PATENTABLY DISTINCT INVENTIONS**

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent (see MPEP §§ 802.01, 806.04, 808.01) or distinct as claimed (see MPEP §§ 806.05-806.05(I)); and
- (2) There must be a serious burden on the Examiner if restriction is not required (see MPEP §§ 803.02, 806.04(a)-(j), 808.01(a) and 808.02).

**GUIDELINES**

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases.

The Examiner has not shown that there would be a serious burden to examine both of Groups I and II. It is not understood how the search would possibly be burdensome, since the composition recited in claim 1 of Group I is also a recited element of claim 20 of Group II, i.e. the claims of Group I and II recite the same composition. Therefore, the search that has already been done for Group I would necessarily have to be done for Group II.

Applicant also notes that in the Final Office Action of the parent application mailed October 28, 1997, the restriction requirement was withdrawn by the Examiner. Therefore, it is Applicant's position that in view of the Examiner's past response the identical restriction requirement made here should be withdrawn.

For the above reasons, the restriction requirement is believed to be in error and should be withdrawn.

**II. Rejection of Claims 1-11, 18, 19, 22, and 23 under 35 U.S.C. §103(a) In the parent application Serial No. 08/694,591**

In the parent application Serial No. 08/694,591, the Examiner rejected claims 1-11, 18, 19, 22 and 23 under 35 U.S.C. §103(a) as being unpatentable over EPA '604 in view of Sramek. It was his position that it would have been obvious to modify the composition of Sramek by adding the polymer and surfactant of EPA '604 in order to achieve good freeze thaw stability. This rejection does not apply to the claims, as amended and newly added.

In determining obviousness under 35 U.S.C. § 103, the Examiner carries the initial burden of setting forth a *prima facie* case of obviousness that satisfies the Graham v. John Deere Co., 383 U.S. 1 (1966) standard for patentability. M.P.E.P. § 2141. The Examiner's evaluation must adhere to the following tenets of patent law:

- (1) The claimed invention must be considered as a whole;
- (2) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (3) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (4) Reasonable expectation of success is the standard with which obviousness is determined.

[M.P.E.P. § 2141.]

If the Examiner does not establish a *prima facie* case of obviousness, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. § 2142; see also In re Mayne, 104 F.3d 1339, 1342 (Fed. Cir. 1997)(citing In re Dillon, 919 F.2d 688, 692 (Fed. Cir. 1990) (en banc) "when the PTO shows *prima facie* obviousness, the burden then shifts to the applicant to rebut [that conclusion].") Unless and until *prima facie* obviousness is established, both the Examiner and applicant are relieved from evaluating evidence beyond the prior art and the evidence in the specification as filed. M.P.E.P. § 2142.

With the foregoing in mind, Applicant maintains that the Examiner's previous rejection in the parent case should not be applied to the claims in this application, as amended and newly added.

Claim 1, as amended, of the instant application recites:

A cosmetic composition comprising, in a cosmetically acceptable aqueous or aqueous/alcoholic medium,

at least one acrylic copolymer formed from (a) approximately 35 to 75 % by weight of an alkyl acrylate, (b) approximately 25 to 65 % of alkyl methacrylate and (c) approximately 1 to 15 % of at least one ethylenic carboxylic acid having from 3 to 5 carbon atoms, the alkyl radicals having from 1 to 5 carbon atoms and the percentages being expressed with respect to the total weight of the copolymer, and

at least one polymer selected from a fixing polymer and a conditioning polymer, wherein said polymer is chosen from amphoteric polymers.

EPA '604 teaches that often when aqueous based polymer compositions are subjected to freezing and thawing, a substantial increase in viscosity can occur,

which increase can adversely affect the performance of hair spray compositions. To combat this "freeze-thaw" problem in hair spray compositions while still achieving a composition that provides excellent curl retention, drying time, feel, shine, combability, tackiness, and flaking resistance, EPA '604 teaches controlling the particle size of the copolymer active ingredient plus the addition of a surfactant to enhance the freeze-thaw stability. (See page 2, lines 24-39.)

Moreover, the reference goes on to teach that enhancing the freeze-thaw stability of the polymer composition depends on the use of certain types of nonionic surfactants in the final polymer composition, since these surfactants effectively inhibit the flocculation and viscosity increases due to subjection to freeze-thaw cycles. (See page 3, line 56- page 4, line 10.) Thus, one of ordinary skill in the art reading EPA '604 readily comprehends that the interaction between the particularly sized polymer and the nonionic surfactant is extremely important to achieving the hairspray composition having the "excellent" freeze-thaw stability. Significantly, EPA '604 contains not a single word about adding any other polymer to the mix for any purpose, let alone an amphoteric polymer.

Sramek discloses a hair setting/hairspray composition in the form of a pump spray or self-pressurized aerosol composition that employs a carboxyl radical-functional hairspray resin, such as BASF ULTRAHOLD, which, of great significance, according to Sramek, has been neutralized with a specific type of long chain amine.

This neutralized resin possesses improved adhesion to the hair and removability from the hair upon washing. (See column 2, lines 55-66 of Sramek.)

It was the Examiner's position in the parent case that based on the disclosure of achieving good freeze-thaw stability in EPA '604, one of ordinary skill in the art would have found it obvious to combine the polymer and surfactant of EP '604 with the aerosol composition of Sramek that includes BASF ULTRAHOLD. It is applicants contention that the Examiner's conclusion stated above impermissibly focuses on what the skilled artisan might try, rather than what the prior art would have led the skilled person to do.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260,1266 (Fed. Cir. 1992). In other words, the proper test that should be applied to determine whether the claimed invention is obvious is what the prior art would reasonably have led the skilled person to do, not what the skilled person might try or find obvious to try. See In re Dow Chemical, 837 F.2d 469, 473 (Fed. Cir. 1988) (obviousness is to be evaluated by looking to see if, in light of the prior art, there would be a suggestion to the ordinarily skilled artisan to carry out the modification and there would be a reasonable likelihood of success).

The "might try" analysis is flawed with impermissible hindsight. Courts have reasoned that the best defense against the powerful attraction of a hindsight based

obviousness analysis is "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references;" a showing that must be "clear and particular." See *In re Dembiczak*, Civil Action No. 98-1498. The Federal Circuit recently instructed that this requirement is taken directly from section 103 to guard against the PTO's entry into the "tempting but forbidden zone of hindsight." *Id.*

Moreover, courts have additionally cautioned that broad, conclusory statements regarding the teachings of the cited references, much like those offered by the Examiner in the present matter, never satisfy the motivation burden. *Id.*

The Federal Circuit most recently applied the above cited principles in the April 1999 decision *In re Dembiczak*. Civil Action No. 98-1498, Application No. 08/427,732 (Fed. Cir. 1999). In that case, the Court reversed a Board of Appeals' and Commissioner of Patents and Trademarks' finding that a garbage bag designed to resemble a jack-o-lantern had been rendered obvious by prior art references disclosing garbage bag technology and the decoration of paper bags. In support of its reversal, the Court instructed that the Board had not only failed to make "specific or even inferential findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that may serve to support a proper obviousness analysis," it had also failed to instruct how the cited references combined to yield the claimed invention. *Id.*

In view of these shortcomings, the *Dembiczak* Court reversed the Office's rejection of the claims without even considering the parties' arguments on secondary considerations since the Board had failed to establish a *prima facie* case of obviousness. One would be hard pressed to find an invention more basic than the mere decoration of a garbage bag to resemble a jack-o-lantern, which invention pales in sophistication compared to the cosmetic composition claimed herein containing a acrylic complex copolymer.

The *Dembiczak* ruling is relevant to the instant appeal not only for its detailed explanation of the law, but also for its application of that law to a fact pattern that closely resembles the factual record before this Board. In particular, the invention of EPA '604 is an aqueous based hairspray composition with low levels of volatile organic compounds that also has good freeze- thaw stability. EPA '604 teaches that such compositions arise from the combination and interaction of the anionic acrylic polymer, i.e. the active hair setting ingredient, having a particular particle size and the nonionic surfactant. There is not even a word of suggestion about adding any additional polymer, let alone an amphoteric polymer, and thus entirely no suggestion as to whether it would be reasonable to expect that such an unsuggested combination would maintain the enhanced freeze-thaw stability that is the overwhelming object of EPA '604.

In fact, in view of the emphasis by EPA '604 on the interaction between the anionic polymer and the nonionic surfactant, the skilled artisan would conclude that



this interaction is necessary to achieving the freeze-thaw stability. The skilled artisan therefore, would have no motivation, absent an express suggestion found in the prior art, to use this combination in the presence of another hair-resin polymer, particularly an amphoteric polymer, which might interfere with that interaction.

In stark contrast, Sramek is not at all concerned with freeze-thaw stability. Rather, as indicated above, the invention of Sramek is a hairspray composition that has improved adhesion and is readily removable from the hair, which is accomplished by what Sramek makes clear is necessary amine modification of known hair setting resins such as BASF ULTRAHOLD. Sramek will be searched in vain for any suggestion of the desirability of combining his amine-modified resins with any other polymer, much less the specific polymers of EPA '604.

In view of this disclosure, one of ordinary skill in the art would not have had any motivation to combine any teaching of Sramek with any teaching of EPA '607 to obtain the claimed invention, as amended.

In view of the foregoing, it is Applicant's position that the prior art applied in the parent case, when viewed as a whole, would not have led the skilled person to make the modification suggested by the Examiner with respect to the claims as amended. Thus, the references relied on in the parent case fail to produce a *prima facie* case of obviousness with respect to the claims, as amended.

In an Information Disclosure Statement filed herewith, Applicant has provided two articles assumed *arguendo*, based on present knowledge, to constitute prior art.

The Examiner's attention is directed to the eighth page of "Amerhold™ DR-25: The water-based hair spray technology that performs beautifully." That page states that Amerhold DR-25 is also compatible with most of the commonly used solution resins, such as PVP, PVP/VA and other acrylates, and that inclusion of other resins may enhance the performance of finished products containing Amerhold DR-25.

None of the resins recited is amphoteric. There is absolutely, therefore, no suggestion in this document that would motivate one skilled in the art to combine Amerhold DR-25 with an amphoteric fixing or conditioning polymer.

The only formulation reported in this document that is relevant is at the page numbered 16, entitled "55% VOC Hair Spray, T75-262-9." The formulation discloses use of PVP/VA copolymer, which is not amphoteric, and Lubrajel Oil, which is also not an amphoteric polymer. Thus, as stated above, the article contains no suggestion to use an amphoteric conditioning or fixing polymer, and claim 1, as amended, requires the fixing and/or conditioning polymer to be chosen from amphoteric polymers. Therefore, the claims as amended are clearly patentable over this article.

In the other newly cited prior art, "Novel New Hair Spray Resin Utilizing Aqueous Dispersion Technology for 0 - 80 % VOC Systems," the Examiner's attention is directed to page 4, reciting at the bottom of the page an Amerchol prototype utilizing 7% ADR as the primary hair spray resin, 2% PVA/VA 735, and a small amount of glycerol polymethacrylate/propylene glycol/PVM/MA. This

disclosure is very similar to that at page 16 of the other article and for the same reasons, does not suggest the claims, as amended, reciting that the conditioning or fixing polymer is amphoteric.

In view of the foregoing, Applicant respectfully contends that the pending claims in this application are allowable over the prior art and requests early indication of the same.

Please grant any extensions of time required to enter this Response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: Thomas L. Irving  
Thomas L. Irving  
Reg. No. 28,619  
by Allen R. Jensen  
Allen R. Jensen  
Reg. No. 28,224

Date: July 6, 1999